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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,946	09/22/2003	Baldomero M. Olivera	2314-266	7093
6449	7590	01/20/2006	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			CARLSON, KAREN C	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/666,946	Applicant(s) OLIVERA, BALDOMERO M.	
	Examiner Karen Cochran Carlson, Ph.D.	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

The Examiner has perused the specification in search of definitions for "arresting", "protecting", and "preserving" an organ, and no such definitions are found. Thus, the Examiner is separating the independent Claim 1 (for example) into 3 different methods because stopping a heart, protecting a heart (from ischemia, for example) and preserving a heart are wholly different effects. Additionally, for example, independent Claim 1 states that the conopeptide will be administered to a subject while dependent claims 3 and 4 state that the organ is either in the subject or isolated or taken out of the subject. This is confusing; thus, these claims have also been separated into a group for administering conopeptide to a subject versus administering the conopeptide to an organ. These inventions are considered to be independent and patentably distinct.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18 and 32-34, drawn to a method for arresting an organ in a subject by administering conopeptide and adenocine receptor agonist, classified in class 514, subclass 2.
- II. Claims 1-18 and 32-34, drawn to a method for protecting an organ in a subject by administering conopeptide and adenocine receptor agonist, classified in class 514, subclass 2.
- III. Claims 1-18 and 32-34, drawn to a method for preserving an organ in a subject by administering conopeptide and adenocine receptor agonist, classified in class 514, subclass 2.
- IV. Claims 3, 4, and 11-16, drawn to a method for arresting an isolated organ by administering conopeptide and adenocine receptor agonist, classified in class 514, subclass 2.

Art Unit: 1653

- V. Claims 3, 4, and 11-16, drawn to a method for protecting an isolated organ by administering conopeptide and adenocine receptor agonist, classified in class 514, subclass 2.
- VI. Claims 3, 4, and 11-16, drawn to a method for preserving an isolated organ by administering conopeptide and adenocine receptor agonist, classified in class 514, subclass 2.
- VII. Claims 1, 19-21, and 32-34, drawn to a method for arresting an organ in a subject by administering conopeptide and local anesthetics, classified in class 514, subclass 2.
- VIII. Claims 1, 19-21, and 32-34, drawn to a method for protecting an organ in a subject by administering conopeptide and local anesthetics, classified in class 514, subclass 2.
- IX. Claims 1, 19-21, and 32-34, drawn to a method for preserving an organ in a subject by administering conopeptide and local anesthetics, classified in class 514, subclass 2.
- X. Claims 1, 22, 23, and 32-34, drawn to a method for arresting an organ in a subject by administering conopeptide and potassium channel opener, classified in class 514, subclass 2.
- XI. Claims 1, 22, 23, and 32-34, drawn to a method for protecting an organ in a subject by administering conopeptide and potassium channel opener, classified in class 514, subclass 2.
- XII. Claims 1, 22, 23, and 32-34, drawn to a method for preserving an organ in a subject by administering conopeptide and potassium channel opener, classified in class 514, subclass 2.

Art Unit: 1653

- XIII. Claims 1, 24-29, and 32-34, drawn to a method for arresting an organ in a subject by administering conopeptide and hemostatic agent, classified in class 514, subclass 2.
- XIV. Claims 1, 24-29, and 32-34, drawn to a method for protecting an organ in a subject by administering conopeptide and hemostatic agent, classified in class 514, subclass 2.
- XV. Claims 1, 24-29, and 32-34, drawn to a method for preserving an organ in a subject by administering conopeptide and hemostatic agent, classified in class 514, subclass 2.
- XVI. Claims 1, 30, 31, and 32-34, drawn to a method for arresting an organ in a subject by administering conopeptide and AV blocker, classified in class 514, subclass 2.
- XVII. Claims 1, 30, 31, and 32-34, drawn to a method for protecting an organ in a subject by administering conopeptide and AV blocker, classified in class 514, subclass 2.
- XVIII. Claims 1, 30, 31, and 32-34, drawn to a method for preserving an organ in a subject by administering conopeptide and AV blocker, classified in class 514, subclass 2.
- XIX. Claims 35-38, drawn to method for identifying drug candidates that arrest organs, classified in class 435, subclass 7.1.
- XX. Claims 35-38, drawn to method for identifying drug candidates that protect organs, classified in class 435, subclass 7.1.
- XXI. Claims 35-38, drawn to method for identifying drug candidates that preserve organs, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1653

The methods of Inventions 1-21 require different products and steps and have different endpoints. Therefore, Inventions 1-21 are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER